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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,383	05/05/2001	Andrea R. Brady	LBL1028U	8207

25197 7590 09/16/2004

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EXAMINER

MILLER, WILLIAM L

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/849,383

Applicant(s)

BRADY ET AL.

Examiner

William L. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,12-15 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-25 is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,12-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06-01-2004 has been entered.

### ***Claim Objections***

2. Claims 18 and 19 are objected to because of the following informalities: "said strand of beads" lacks antecedent basis. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. Claims 15, 20, and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The user (i.e. user's skin) cannot be positively claimed.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6-8, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benedek et al. (US#4562704) in view of Swaim (US#5279132).

6. Regarding claim 1, Benedek discloses a beaded fashion accessory comprising a strand of material (metal chain) 1 and a plurality of beads 30. Benedek fails to disclose an adhesive as

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claimed by the applicant. However, Swaim teaches an adhesive for use with body ornaments such as necklaces, bracelets, and the like so that the ornament may be held in place on a wearer's body to prevent the ornament from becoming displaced thereby maintaining proper orientation of the ornament on the wearer's body (abstract). Therefore, as taught by Swaim, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Benedek by utilizing an adhesive for connecting the plurality of beads directly to the skin of the user thereby preventing the beads from becoming displaced and maintaining proper orientation of the beads on the wearer's body.

7. Regarding claim 2, the beads include holes 32.

8. Regarding claim 6, the strand is preformed into a design being viewed as configuration shown in Fig. 1.

9. Regarding claims 7, 8, 18, and 19, although Benedek fails to specifically disclose the length of the strand of beads, it would have been an obvious design choice to utilize the claimed lengths as a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

10. Regarding claim 17, the strand of material is malleable as it can be formed of gold or silver (col. 2, lines 32-34).

11. Claims 3, 5, 14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benedek in view of Swaim as applied to claim 1 above, and further in view of Fossas (US#4718252).

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12. Regarding claims 3, 5, 14, and 21, Benedek discloses the strand of material as a metal chain as opposed to string, wire, or fabric as claimed by the applicant. However, Fossas teaches in col. 3, lines 4-10, a chain, string, wire, and fabric (thread or fiber) are art recognized equivalents in the jewelry art and therefore it would have been obvious to one of ordinary skill in the art to substitute one for the other. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982).

13. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benedek in view of Swaim as applied to claim 1 above, and further in view of Hector (US#5590546).

14. Benedek discloses a single strand of beads (Fig. 4) as opposed a plurality of strands of beads being woven to form a two-dimensional array of beads as claimed by the applicant. However, Hector teaches a jewelry accessory including a plurality of strands of beads being woven to form a two-dimensional array of beads to provide aesthetic versatility (Figs. 1-29 and abstract) . Therefore, as taught by Hector, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Benedek to include a plurality of strands of beads being woven to form a two-dimensional array of beads to provide aesthetic versatility.

***Allowable Subject Matter***

15. Claims 23-25 are allowed.

***Response to Arguments***

16. Regarding claim 1, the applicant argues Swaim teaches the adhesive holds a discrete portion of a piece of jewelry in place, not the entire item. The examiner agrees, however claim 1

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does not require the entire item to be held in place by the adhesive. Claims 15, 20, 22, and 23 include a limitation whereby the entire item is held in place by the adhesive (i.e. along an entire length) and have not been rejected via the prior art. Swaim teaches an ornament of the necklace is adhered directly to the user's skin via an adhesive. This teaching has been translated to Benedek such that the ornament (bead) of the necklace is adhered directly to the user's skin via an adhesive.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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William L. Miller  
Primary Examiner  
Art Unit 3677

WLM  
09-14-2004

A handwritten signature in black ink, appearing to be 'WLM', written over the printed name of William L. Miller.